# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/768,482 | 01/23/2001 | Greg Wiggins | 4242.1 P | 1535 |

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| EXAMINER |
|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 2122 | |

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/768,482 | WIGGINS ET AL. |
| | Examiner | Art Unit |
| | Ted T. Vo | 2122 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *20 October 2004*.

2a) ☐ This action is **FINAL**.  2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1 and 3-18* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1 and 3-18* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All  b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

1.      This action is in response to the Applicants' filing request for continued examination on

10/20/2004.

Claims 1, 3-18 remain pending in the application.

### *Response to Arguments*

2.      Applicants' arguments given in their Remarks (pages 8-10) have been fully considered.

For example, for arguing Claim 1,

"Applicants point out that the descriptions of figures D and E in this reference indicate that figure
D shows "Winzip's detailed Drag and Drop dialog box" to give "you another way to add files to
your archive" and figure E shows "You can make regular ZIP files self-extracting with the Winzip
Self-Extractor Personal Edition dialog box" Neither describe or even suggest the auto-migration
package claimed by the applicants in claim 1"
(Remarks, page 9, item 7),

Examiner respectfully responds:  A claimed limitation should impart functionality in order to

distinguish over a prior art.

Regarding Claim 1:

-Limitations within (A) and (B) are mere computer sets that are known in the art.

-Limitations within (C) is a mere file ('application program') stored in the computer sets.

-Limitations (D)(1) and (D)(2) are a file (INI file) and a common network connected between computer (A)

and computer (B) wiredly or wirelessly.  These limitations recite the well-known things in the art.  Thus,

the reference of Kahani discloses the elements/terminologies such as WWW and .INI file format are

clearly addressing these common elements in the claim.  For example, WWW is known as an internet

element that has means as communication channels connected at least two computers.  And each

computer has been known for having hard deriver/memory storing application programs or files.

Furthermore, (D) recites a means for migrating the file ('application program'); however, it is only

a mere migrating. Elements (1), (3), and (4) do impart functionality or interrelationships to other elements,

but a mere list of files that might be sent or stored to/in a computer. It should be noted that "WWW" has

means for sending any files. Thus a file and WWW, particularly, a ZIP file as teaching in Kahani, has

means as recited.

It should be noted that, the limitations (D)(1), (D)(2), (D)(3), and (D)(4) do not impart any functionality

toward migrating means, but rather the files **in a computer.**

Applicants are respectfully referred to MPEP 2106:

> In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). Nonfunctional
> descriptive material cannot render nonobvious an invention that would have otherwise been
> obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 **USPQ** 401, 404 (Fed. Cir. 1983) (when
> descriptive material is not functionally related to the substrate, the descriptive material will not
> distinguish the invention from the prior art in terms of patentability)" (emphasis added).

> MPEP 2106 IV B 1 (b) indicates that "nonfunctional descriptive material" is material "that cannot
> exhibit any functional interrelationship with the way in which computing processes are
> performed".

Examples of "nonfunctional descriptive material" include certain types of "printed matter".

> MPEP 2112.01 indicates that "Where the only difference between a prior art product and a
> claimed product is printed matter that is not functionally related to the product, the content of the
> printed matter will not distinguish the claimed product from the prior art. In re Ngai, ___ F.3d ___,
> 2004 WL 1068957 (Fed. Cir. May 13, 2004)(Claim at issue was a kit requiring instructions and
> a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that
> taught a kit that included instructions and a buffer agent, **even though the content of the
> instructions differed**.). See also In re Gulack, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404
> (Fed. Cir. 1983)("Where the printed matter is not functionally related to the substrate, the printed
> matter will not distinguish the invention from the prior art in terms of patentability .... [T ]he critical
> question is whether there exists any new and unobvious functional relationship between the
> printed matter and the substrate."

A limitation in a claim that does not impart functionality or it is not functionally related to the

means of the claim would be a descriptive material, and would not make it be different from a reference.

The limitation that is functional related to the means such as (D)(2) would be common because any

computer connected in WWW has a communication channel.

With regards to Applicants' argument in the item 7, it is noted that the reference addresses:

Create Self-extracting ZIP files. In light of the specification, **The ZIP files described by this reference**

**has means "self-extracting auto-migrating package**. It should be noted that Figures D and E are the

elements used for building a package only.

With regards to Applicants' arguments in item 5 (pages 8-9), Examiner respectfully responds: All

claimed limitations recited in Claim 3 could be performed manually by manipulating the WINZIP. The

Window operating system such as Microsoft Windows 95, installed with the WinZip, can perform the steps

of the claim. It should be noted that such a window contain registry, and a user can use registry editor to

manipulate the files, particularly, the files in the Zip file created by WinZip.

### Claim Rejections - 35 USC § 103

3.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as
set forth in section 102 of this title, if the differences between the subject matter sought to be
patented and the prior art are such that the subject matter as a whole would have been obvious
at the time the invention was made to a person having ordinary skill in the art to which said
subject matter pertains. Patentability shall not be negatived by the manner in which the invention
was made.

4.      Claims 1, 4-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahani,

WWWCopy™ Version 1.1 (a description of a download version appeared in the Internet, July 1997), in

view of Inside the Internet, "Create self-extracting ZIP files with WinZip 6.3", ProQuest Computing, 5-

2000.

Given the broadest reasonable interpretation of followed claims in light of the specification.

<u>As per claim 1</u>:

Regarding claim limitation: "A system for describing and extracting application information, comprising:

*(A) a first computer system, said first computer system further comprising:(1) an input device; (2) a display device; and (3) a processing unit, said processing unit further comprising:(a) a processor;(b) memory; and(c) a long-term storage device;* (re: Kahani: inherent in a computer, at given URL, e.g. see figure on p.2, at "http://130.130.88.201/...")

*(B) a second computer system, said second computer system further comprising:(1) an input device; (2) a display device; and (3) a processing unit, said processing unit further comprising:(a) a processor;(b) memory; and(c) a long-term storage device;* (re: Kahani: inherent in a computer, at local site running the display window on p.2)

*(C) an application program resident on said long term storage device of said processing unit of said first computer system* (re: Kahani: inherent in a file directory in a computer, memory of the computer at given URL so that "shareware" can be downloaded/distributed); and

*(D) a means for migrating said application program from said first computer to said second computer,* (re: Kahani: inherent in a modem installed in a computer).

Kahani describes a shareware that covers above limitations, wherein said means for migrating further comprises: (1) an application interface file, in an INI format, (see page 1, Table of contents, '.ini file format') wherein said application interface file further comprises a tag that identifies a feature of said application program (see page 5, section 3.4, [PREF], FRAME, IMG, in .ini file format); (2) a communication channel between said first computer system and said second computer system (see page 2, 'http://... 'shown in a popup window). Furthermore, Kahani discusses a 'WWWCopy shareware' (application program) that is stored in a first computer, provided (downloaded) to second computer. A WWWCopy is packed in a WWWCopy.zip and installed in the second computer (see page 3, section 3.1, 'How to install WWWCopy), where the WWWCopy.zip includes file WWWCopy.ini in INI format, and

where the format includes tags such as PREF tag, or tags linked to HTML such as FRAME, IMG, etc.

(see page 5, section 3.4). When the WWWCopy is run in combined with a URL page (page 1, section 1,

'What is WWWCopy'), tag preferences in the INI format file will be described in a popup window (Dialog

window of page 4). The popup window shows containing information of the WWWCopy shareware.

Kahani does not expressly show:

*"(3) a console module in communication with said applicant interface file; and*

*(4) a self-extracting auto-migration package built by said console module"*

Inside the Internet reference shows a WinZip 6.3 that includes a Dag and Drop dialog box (re:

Inside the Internet; Page 14, Figure D) used to build a WinZip self-extractor package (re: Inside the

Internet; Page 14, Figure E) to send to an intended recipient (re: Inside the Internet; see page 13, right

column, last paragraph) for covering the limitation of **(3)** and **(4)** above.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of

invention was made to combine the teaching of Kahani which teaches sending out a personal package

that includes a INI file in the ZIP file, and the teaching of Inside the Internet for creating a self-extractor

included with the features of migrating and extracting files.

Doing so would allow a user to send or receive files automatically in a compact manner.


Regarding further limitations of Claims 4-17:

Inside the Internet reference discloses the further features of ***"(3) a console module in***

***communication with said applicant interface file; and (4) a self-extracting auto-migration package***

***built by said console module",*** as address above, where Inside the Internet further covers the extended

features of limitations of (3) and (4) that limit within the claim limitations of Claims 4-17:

As per Claim 4: Inside the Internet further shows the WinZip 6.3 with ADD (re: Inside the Internet,

Figure B, page 13) or Drag and Drop (re: Inside the Internet, Figure D, page 14), and WinZip Self-

Extractor Personal Edition (re: Inside the Internet, Figure E, page 14) for creating self-extractor packages.

As per Claim 5: Inside the Internet further shows the WinZip 6.3 which is adaptable to a standard Window like Window 95, where the WinZip like the one in Figure C (page 13) can edit a file using "FILE" adaptable by the Window 95.

As per Claim 6: With regard to limitation of Claim 6, see all the buttons shown in the Figure C, to provide a user who creates a package to determine the setting and file types.

As per Claim 7: With regard to limitation of Claim 7, see page 12, right column, last paragraph; Self-Extracting Zip file is an executable file.

As per Claim 8: With regard to limitation of Claim 8, see page 12, right column, last paragraph, "recipient", who receives the Self-Extracting Zip file.

As per Claim 9: With regard to limitation of Claim 9, see page 14, right column, first paragraph, "attachment to your email".

As per Claim 10: With regard to limitation of Claim 10, see page 12, Figure A "FILE", or button "OPEN", where "FILE" is known as allowing a user to edit a file.

As per Claim 11: With regard to limitation of Claim 11, see page 13, Figure B, button "Password".

As per Claim 12: With regard to limitation of Claim 12, see page 12, right column, paragraph Why Zip Your File?" and "compression files to save space".

As per Claim 13: With regard to limitation of Claim 13, see page 12, Figure C, all Buttons (such as EXTRACT", haves means of operating system conversion.

As per Claim 14: With regard to limitation of Claim 14, see page 13, Figure C, the features shown in the bottom line of the WinZip such as byte selected, size of a file.

As per Claim 15: With regard to limitation of Claim 15, see page 13, Figure C, line that describes in text such as name, date, time etc., of a file in the WinZip.

As per Claim 16: With regard to limitation of Claim 16, see page 13, Figure C, button NEW or ADD, where these buttons allow a file to be duplicated and migrated in the Self-Extractor.

As per Claim 17: With regard to limitation of Claim 17, see page 13, Figure C, button ADD or EXTRACT, where the EXTRACT is known as unattended installation of the files.

Regarding further limitations of Claim 18:

As per Claim 18: Inside the Internet reference does not express show Self-extracting auto-migration package further comprises "*user-defined profiles*"

Official notice is taken that User-defined profiles are well-known in the art where the feature of "user-defined profiles" is used commonly for retaining user's data/information set by a user and maintained by Windows operating system for password protection and network connection. Figure B suggests "user-defined profiles" by showing button Password.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to include "User-defined Profiles" because it is used by a user for retaining user's data/information which is necessary for establishing a connection with a network.

5.      Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inside the Internet, "Create self-extracting ZIP files with WinZip 6.3" (ProQuest Computing), in view of WinZip Version 7.0 (Nico Mak Computing).

Given the broadest reasonable interpretation of followed claims in light of the specification:
As per claim 3:

Inside the Internet discloses:

(A) loading a Personality Package, said Personality Package further comprising setting, preferences applications, data fields  (see page 14, Figure E, a WinZip self-extractor that contains files/applications, is figured out to be extracted);

(B) executing said Personality Package (see page 12, right column, last paragraph, self-extracting ZIP file is an executable program);

(C) getting a file; (D) copying said file; and determining whether migration of additional files is required and if additional files are required returning to said getting a file step; (see popup window in page

13, Figure C, it shows that files art selected and copied into the open area, based on buttons such as

NEW, OPEN, ADD, CHECKOUT, etc.).

> *(E) getting a registry; (F) copying said registry;*
>
> *(G) getting application version specifics, and testing to determine if destination application*

*version match and generating an error if said destination application versions do not match; and (H)*

*updating links* (See page 13, right column, last paragraph, WinZip has ability to test to make sure file

functionality before sending it to an intended recipient).

Inside the Internet does not explicitly disclose "registry".

Nico Mak Computing discloses,

> *(E) getting a registry; (F) copying said registry* (see WinZip® Version 7.0, page 1, paragraph,

"WinZip now uses the registry instead of Winzip32.ini...").

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of

invention was made to combine the teaching of Inside the Internet to the WinZip version 6.3 to the WinZip

version 7.0 disclosed by NiCo Mak Computing. Doing so would conform to the operating requirement of

standard Windows, such as Win95 or WinNT that provides registry/registry editor for registering files

installed in its window operating system.


## *Conclusion*


6.        Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be

reached on 8:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan

Q. Dam can be reached on (571) 272-3694. The fax phone number for the organization where this

application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be obtained from

either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC)

at 866-217-9197 (toll-free).

Ted T. Vo
Patent Examiner
Art Unit 2122
February 25, 2005